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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/058,840 04/13/98 WALKER J 3178-4021US1

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LM02/0712

EXAMINER

LAUFER, P

ART UNIT

PAPER NUMBER

2766

DATE MAILED:

07/12/99

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/058,840

Applicant(s)

Walker et al.

Examiner

703 306 V/60
Pinchus M. Laufer

Group Art Unit

2766



☒ Responsive to communication(s) filed on 22 Jun 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 97-121 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 97-121 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Part III DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Continued Prosecution Application

2. The request filed on 22 June 1999 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/058,840 is acceptable and a CPA has been established. An action on the CPA follows.

Fee Calculations

3. The fee calculation and check accompanying the application were based on 96 total claims of which 5 are independent claims yielding a total fee of \$1142. as a small entity. There are actually 25 total claims of which 9 are independent in the case as filed which would only require a fee of \$659. as a small entity. Applicant may apply for a refund to the appropriate office.

Claim Rejections - 35 U.S.C. § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 97-108, 110, and 112 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 97-108, and 112 are directed to matter which is not within the technological arts. *See Examination Guidelines for Computer Related Inventions 1184 OG 87 (3/26/1996) II.A* which states: The utility of an invention must be within the "technological" arts⁷. (*See Guidelines, 1184 OG at 95, Endnote 7.*)

Note that Claim 112 is a *method of using a computer* not a computer implemented method. That is, (as claimed) the computer is not performing the method, but is merely used as a tool in the performance of the method by the user. That is, the scope of the claim includes using the computer to store the inputted conditional purchase offer and identifier, while all the other steps may be performed independent of the computer.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. *See In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 97-121 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11, 12, 23, and 34 of U.S. Patent No. 5,794,207 issued 11 August 1998. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of claims 97-114, and 116-120 of the instant application are taught in the claims of the issued patent. With respect to claims 97-108, 112-114, and 116-120 the patent is claimed more narrowly than the application as the steps are performed with the aid of a computer. Claim 12 of the patent differs from claim 109 of the application in that it requires a "credit card account" as opposed to the more general "financial account". Claims 23 and 34 of the patent have a "request for authorization" which is not in claims 110 and 111 of the application. With respect to claim 115 implementation using the Internet would have been obvious to one of ordinary skill the art, as this is the most widespread "electronic network", and with respect to claim 121, the ability to counteroffer would be an obvious modification for any implementation of a transaction system since it does not leave the transaction initiator to continually change his terms without the symmetry of return information.

Observation on Claim Language

8. Note that claims 119-121 do not claim presenting the offer to multiple sellers.

Claim Rejections - 35 U.S.C. § 112

9. Claims 118 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "substantially simultaneously" (line 2) is a relative term which renders the claim indefinite. The term "substantially" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite range, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The degree of simultaneity is rendered indefinite by this language. That is, the time frame is uncertain.

10. Claims 119-121 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps in Claim 119 are:- presenting the offer to potential sellers; receiving an acceptance of the offer from a seller (or conditions under which an acceptance of the offer is authorized).

The omitted steps in Claim 121 are:- presenting the offer to potential sellers; receiving a counteroffer to the offer from a seller (or conditions under which a counteroffer is authorized).

Claim Rejections - 35 U.S.C. § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12. Claims 97-99, 101-113 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Sibley, Jr. ('552). The bids are offers, the traders have associated financial accounts to back up their trades and there is a settlement procedure for transferring payment. With respect to claim 110 the authorization to use the payment identifier is inherent in the charge back to the trader

13. Claims 119-121 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Mandler et al. ('400). See Figures 4A-2 and 4A-3.

14. Claims 97-121 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Huberman ('244). Note that the bid is a conditional purchase offer in that it contains conditions which buyer requires to be met. Credit card accounts are discussed as one payment method at column 6 line 41.

Claim Rejections - 35 U.S.C. § 103

15. Claims 110 and 114-121 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sibley ('552). Sibley does not teach a system where the financial account is a credit card account. At the time the invention was made, trading stocks and commodities through discount brokerages

was common. Many of the discount brokerages require either a positive balance or a credit card with adequate funds to cover any submitted trade. Therefore, in light of this practice it would have been an obvious extension of Sibley ('552) to use a credit card account as the financial account. Alternatively, since a credit card account is a very common financial account it would have been obvious to implement Sibley using credit card accounts since there is a worldwide infrastructure in place to handle transaction settlement.

Conclusion

16. This is a CPA of applicant's earlier Application No. 09/058,840. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Information Regarding Communication with the PTO

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pinchus M. Laufer whose telephone number is (703) 306-4160. The examiner can normally be reached on weekdays from 7:30 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, G. O. Hayes, can be reached on (703) 305-9711. The fax phone number for this Group is (703) 308-9051.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

July 9, 1999

Pinchus M. Laufer
Pinchus M. Laufer
Art Unit 2766